

PATENT
Attorney Docket No. 1000-1047 (As Amended)

REMARKS

In further support of the claims presented and amendments thereof, Applicants submit the following remarks.

I. Prosecution History

The application was originally filed October 6, 2000 with claim 1-50. The claims were subject to a restriction requirement under 35 U.S.C. §121 and Applicants were required to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Claims 1-16 and 20-35 were elected for further prosecution. During prosecution, claims 51-78 were eventually added. After prosecution on the merits, all claims remained rejected under 35 USC §102 and §103 grounds. Throughout prosecution of the case and at final rejection, patents issued to *Guthrie et al* (US Patent 6,467,686) and *Biorge et al* (US Patent 5,806,045) were the primary references cited against applicants' claims.

Applicant filed a RCE application on March 1, 2004 after final rejection. The RCE application included a submission with substantial claim amendment. Claims 1-68 were cancelled without prejudice, and claims 69-116 remained pending in the case.

An office action dated March 30, 2004 is the subject of this amendment and response. In the office action, claims 69-77, 80, 89-96 and 99 stand rejected under 35 U.S.C. 102(b) as being anticipated by *Biorge et al*. Claims 69-80, 81-83, 84-88, 89-99 and 100-116 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Guthrie et al* in view of *Biorge et al*. Applicants have amended independent claims 69, 81, 84, 89, 100 and 110 and submit the following remarks. Applicant respectfully request reconsideration of their claims as amended.

II. Claim Objections.

Claims 69-116 were objected to because the “user profile” is not limited or defined substantially, according to the examiner. The “user profile” is not a required element in Applicants’ claimed invention and has been removed from the claims, which should now overcome the objection.

Claim 69, line 9 was objected to for referring to a “point of said” rather than a “point of sale.” The flawed portion of claim 69 has been removed with the latest amendment and therefore overcomes the objection.

III. Double Patenting.

Claims 72 and 73 were identified by the examiner as referring to duplicate subject matter. Claim 72 refers to “financial award” and claim 73 refers to “financial incentive.” The examiner views these terms as interchangeable in the art. Applicants agree with the examiner that these terms can be considered equivalent and for prosecution purposes will consider them equal. Applicants have cancelled claim 72, thereby removing the double patenting objection issue.

IV. Summary of Applicants’ invention.

PDAs are increasingly being utilized to access information from remote computer networks, such as the “World Wide Web” and the “Internet,” both terms well known in the computer networking arts. PDA users can, for example, download e-mail from the Internet to the PDA. Web sites also exist that permit PDA users to access and download software that may be run on the PDA. For example, some web sites offer information to PDAs in the form of compressed news articles, stock quotes, and other data obtained from a wide variety of other electronic web-based sources.

PATENT
Attorney Docket No. 1000-1047 (As Amended)

Users of handheld devices such as PDAs, pagers and mobile telephony are increasingly relying on such devices to maintain and transmit a variety of personal and business information. Examples of PDA devices that can be utilized in accordance with the method and system of the present invention include the PalmPilot PDA, manufactured and sold by Palm Computing, the Handspring Visor, the IBM Workpad, WINDOW CE compatible devices, RIM Blackberry-family paging devices, Motorola paging devices, and the Symbol SPT-family of PDA-type organizer devices. Hand held devices may be also configured with optical scanning/capturing capabilities. PDA's can be programmed to perform many functions, existing and yet to be created.

A need still exists for nonproprietary handheld devices that can manage and wirelessly negotiate the transfer of negotiable economic credits with a point of sale located in a retail establishment. PDA's are already proven to be flexible, efficient and user friendly portable computers. The present invention adapts personal digital assistants devices (PDAs), which are not owned by the enterprise or retail establishment, but owned by the customers/users themselves, to manage and wirelessly negotiate the transfer of negotiable economic credits with a point of sale located in a retail establishment. One significant feature of the present invention is that it can be utilized at unrelated/unassociated retail establishments and enterprises. The present invention, including systems and methods, is ubiquitous in nature and can therefore avoid limitations inherently associated with prior proprietary-based systems.

In accordance with key features of the present invention, Negotiable economic credit can be transferred from a handheld device adapted to enable a user to communicate through wireless telecommunications networks, access the Internet, store and manage personal data including telephone numbers and a calendar, and also adapted as a nonproprietary device for storing and managing negotiable economic credits within a database residing within the hand held device, at the request of a hand held device user to the point of sale in response

to synchronization of the point of sale with the hand held device. The negotiable economic credit or credits can be then automatically redeemed at the point of sale in response to transferring the negotiable economic credit, or associated data, from the hand held device to the point of sale.

V. Summary of cited art.

U.S. Patent No. 5,806,045 to Biorge et al.

Biorge teaches transaction systems for implementing multiple provider incentive programs electronically for multiple providers. Biorge et al provides a system for collecting, transferring, and distributing funds among participating parties (e.g., merchants, banks, credit providers, coupon clearing houses). The Biorge et al system implements an incentive program that depends on the transfer of data between a customer-carried device and a provider device. The customer carried device (74) and the provider device (76) both take the form of a processor card or "Smart Card." (See column 2, lines 20-31.) Biorge et al does not teach wireless communication between the customer carried device and provider device.

The Biorge et al invention does not teach use of a handheld device that can wirelessly process negotiable economic credits with a retail point of sale AND is adapted to enable a user to communicate through wireless telecommunications networks, access the Internet, store and manage personal data including telephone numbers and a calendar, and also adapted as a nonproprietary device for storing and managing negotiable economic credits within a database residing within the hand held device.

Guthrie et al.

Guthrie et al teach a system and method for managing electronic coupon redemption between a hand held device and a point of sale. Guthrie et al teach

PATENT
Attorney Docket No. 1000-1047 (As Amended)

the use of a proprietary device that is only operable for "coupon" management and redemption at check-out stands located in retail stores. The proprietary device taught by Guthrie et al is referred to as a "personal data collector device that which allows a user to enter product code information from coupons into a memory device, and receive feedback about the nature of information stored in the memory device." (See column 4, lines 36-42.) The personal data collector is limited to coupon-related functions and is not taught as being adapted to enable a user to communicate through wireless telecommunications networks, access the Internet, store and manage personal data including telephone numbers and a calendar, and also adapted as a nonproprietary device for storing and managing negotiable economic credits within a database residing within the hand held device.

VI. Rejection of claims under 35 U.S.C. §102 as being anticipated by Biorge et al. (U.S. Patent No. 5,806,045).

The Examiner rejected claims 69-77, 80, 89-96 and 99 under 35 U.S.C. § 102(b) as being anticipated by *Biorge et al* (hereinafter "*Biorge*"), U.S. Patent No. 5,806,045. Applicants traverse the rejection.

Applicants remind the Examiner that in order to sustain a rejection under 35 U.S.C. § 102(b), the cited reference of *Biorge* must show all of the elements/features taught by the rejected claims. If even one element/feature of the rejected claim(s) is not shown or is lacking in the cited reference, the cited reference is not adequate as the basis for a rejection under 35 U.S.C. § 102(e). The independent claims have been amended to include language that more definitively provides an important, distinct feature of their invention. The independent claims include language that the handheld device is "adapted to enable a user to communicate through wireless telecommunications networks, access the Internet, store and manage personal data including telephone numbers and a calendar, and also adapted as a nonproprietary device for storing and managing negotiable economic credits within a database residing within the

PATENT
Attorney Docket No. 1000-1047 (As Amended)

hand held device. Claim 99 has been cancelled. the rejection of claims 69-77, 80, 89-96 should be withdrawn because *Biorge* does not teach all of the elements of claims 69 and 89. Applicants therefore request withdrawal of the rejections to claims 69-77, 80 and 89-96.

VII. Rejection of claims under 35 U.S.C. §103 as being unpatentable over Guthrie et al (U.S. Patent 6,567,686) in view of Biorge et al.

Claims 69-80, 81-83, 84-88, 89-99 and 100-116 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Guthrie et al (herein "Guthrie") US Patent No. 6,467,686 in view of *Biorge*. Applicants traverse the rejection.

Guthrie discloses a proprietary system for providing electronic coupons or negotiable economic credits to a user over the Internet or any other computer network having a server containing a central repository or database storing the electronic coupon data, wherein the electronic coupon data are downloaded to the user's portable device or handheld device or coupon scanner connected to a cradle. The user has uploaded the coupon scanner of handheld device with the desired coupon data, the user can take the coupon scanner to a retail store where he can redeem the electronic coupons at the retail store checkout through a POS located at the checkout used to upload or transfer the coupon data from the proprietary coupon scanner to the retail store system during a redemption process (Col. 4, line 64 to Col. 5, line 24 of Guthrie).

Applicants have amended independent claims 69, 81, 84, 89, 100 and 110 to include language that more definitively provides an important, distinct feature of their invention. Guthrie et al and Biorge et al, either alone or in combination, do not teach or suggest methods for synchronizing a point of sale with a hand held device device adapted to enable a user to communicate through wireless communications networks, access the Internet, store and manage personal data including telephone numbers and calendars, and store and manage negotiable economic credits, and having at least one (i.e., one or more) negotiable

PATENT
Attorney Docket No. 1000-1047 (As Amended)

economic credit therein. Guthrie et al and Biorge et al, either alone or in combination, do not teach or suggest systems or products for synchronizing a point of sale with a hand held device adapted to enable a user to communicate through wireless communications networks, access the Internet, store and manage personal data including telephone numbers and calendars, and store and manage negotiable economic credits, and having at least one (i.e., one or more) negotiable economic credit therein. Applicants have amended their independent claims as indicated to clarify that their invention was not meant only to provide a proprietary interface limited for use in managing and exchanging simple coupons with a POS. In fact, applicants specifically critiqued proprietary systems within their "background" section of the application because of their limited functionality.

Applicants believe that adequate support is provided by Applicants' specification for their claim amendments. Applicants believe that the arguments presented above with respect to independent claims 69, 81, 84, 89, 100 and 110 apply equally to the rejection of dependent claims dependent claims 68-80, 85-88, 90-98, 101-109 and 11-116. Based on the foregoing, Applicants believe that the rejection to 69-80, 81-83, 84-88, 89-99 and 100-116 has been traversed and they respectfully request that the aforementioned rejections be withdrawn.

VIII. Conclusion

Note that the attorney docket number has been amended so that the original docket number of K1013 was previously cancelled and replaced with the new docket number of 1000-1047. Applicants therefore request that all future correspondence related to the above-captioned patent application refer to the new docket number of 1000-1047 instead of the old docket number of K1013.

The Applicants have clarified the distinctions of the present invention by given the amendments to the claims, and thus the rejections set forth in the Office Action are believed to be traversed. No new subject matter has been

PATENT
Attorney Docket No. 1000-1047 (As Amended)

introduced as a result of the new claims. Accordingly, Applicants respectfully request examination and an early indication of allowability.

Should there be any outstanding matters that need to be resolved in the present application; the Examiner is respectfully requested to contact the undersigned to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

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